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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,735	09/09/2003	Britton Chance	04799-045002	3381
26161	7590	11/28/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SMITH, RUTH S	
			ART UNIT	PAPER NUMBER
			3737	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/658,735

Applicant(s)

CHANCE, BRITTON

Examiner

Ruth S. Smith

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 7, 2006 has been entered.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 47-71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 6,618,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because they involve an obvious broadening of the patented claims. For example, claim 1 of the patent and claim 47 differ in that claim 47 sets forth a light

source and a controller. The use of a light source with the optical fibers and a controller to operate the light source would have been obvious to one skilled in the art in that the fibers set forth in claim 1 are part of an examination device and the fibers are constructed and arranged for transmitting light from a light source. The indexing of fibers is an obvious necessity to ensure that one knows where the detected light was detected on the tissue. With respect to claim 18 of the patent and claim 47 of the application, the deletion of how the fibers protrude would involve an obvious broadening of the claim and the deletion of a second array and its associated function would involve an obvious broadening of the claimed invention. With respect to claim 20 of the patent and claim 47 of the application, the deletion of the peripheral element and its associated function would have involved an obvious broadening of the claimed invention. The use of the apparatus would inherently result in the method to be performed.

Claims 47-71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,526,309. Although the conflicting claims are not identical, they are not patentably distinct from each other because they involve an obvious broadening of the patented claims. For example, claim 27 of the patent and claim 47 differ in that the deletion of the sequencer and its associated function would have involved an obvious broadening of the claimed invention. Furthermore, patent claim 27 includes a spectrophotometer while the application claim sets forth a light source and a detector. The spectrophotometer is a type of light source and detector and the use of such would have been obvious to one skilled in the art to provide the light and light detection necessary to make measurements. Furthermore, the use of a controller to operate the light source would have been obvious to one skilled in the art in that the fibers set forth in claim 27 are part of an examination system and the fibers are constructed and arranged for transmitting light from a light source. The indexing of fibers is an obvious necessity to ensure that one knows where the detected light was detected on the tissue. With respect to claim 39 of the patent and claim 47 of the application, the deletion of how the fibers protrude would involve an obvious broadening of the claim and the deletion of a sequencer and

its associated function would involve an obvious broadening of the claimed invention. The controller used in the application claim 47 provides the functions of the processor set forth in patent claim 39, the functions of the processor which have been deleted in the application claim is considered to be an obvious broadening of the claimed invention. The use of the apparatus would inherently result in the method to be performed.

Claims 47-71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,987,351. Although the conflicting claims are not identical, they are not patentably distinct from each other because they involve an obvious broadening of the patented claims. For example, claim 1 of the patent and claim 47 differ in that claim 47 sets forth a light source and a controller while claim 1 of the patent sets forth a spectrophotometer. The spectrophotometer is a type of light source and the use of such would have been obvious to one skilled in the art to provide the light necessary to make measurements. Furthermore, the use of a controller to operate the light source would have been obvious to one skilled in the art in that the fibers set forth in claim 1 are part of an examination device and the fibers are constructed and arranged for transmitting light from a light source. The indexing of fibers is an obvious necessity to ensure that one knows where the detected light was detected on the tissue. With respect to claim 15 of the patent and claim 47 of the application, the deletion of how the fibers protrude would involve an obvious broadening of the claim and the deletion of a second array and its associated function would involve an obvious broadening of the claimed invention. The use of the apparatus would inherently result in the method to be performed.

### ***Response to Arguments***

Applicant's arguments filed November 7, 2007 have been fully considered but they are not persuasive. The examiner has provided reasoning as to why the application claims are considered to involve an obvious broadening of the patented claims.

Applicant stated that claim 69 corresponds to claim 47, therefore no additional reasoning needs to be set forth for both claims 47 and 69.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3737

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Ruth S. Smith', with a stylized, cursive script.

Ruth S. Smith  
Primary Examiner  
Art Unit 3737

RSS